

under 35 U.S.C. §112. New claim 43 has been added, and is supported at least in part, by specification, pages 5, line 20 to page 11, lines 7-23.

On page 2 of the Office Action, claims 1-15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. This portion of the Office Action objects to the term "publishing" on a file server as recited in claim 1. This objection is respectfully traversed, as the specification describes exemplary embodiments wherein an entity can prepare and issue content onto a server (i.e., "publish" content) for subsequent copying to a particular destination. An entity which places content (e.g., a banner file or a web site) on a server can be considered a publishing entity (see, for example, specification page 6, lines 14-24). As such, use of the term "publishing" in claim 1, is accurate, definite and proper. Such a definition is consistent with the use of this term throughout the World Wide Web by those skilled in the art. Withdrawal of this objection is therefore requested.

In the last sentence on page 2 of the Office Action, the Examiner asserts that "Since it is stated in applicant's comments that the connection is an exclusive connection, the work publishing, has not occurred." Applicant's fail to see how the Examiner's comments support the rejection. Applicant's comments were directed to placement of information on a server, where the information could be accessed and copied to a particular destination. Applicant's use of an accepted term of art can not be considered indefinite, and withdraw of this rejection is requested.

On page 3 of the Office Action, claims 1-4, 6-8, and 10-14 are rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,185,587 (Bernardo et al). On page 4 of the Office Action, claims 1-4 and 6-14 are rejected under 35 U.S.C. §102(e) as being

anticipated by U.S. Patent No. 6,141,010 (Hoyle). On page 5, claims 1-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Bernardo or the Hoyle patent in combination with the Examiner's unsubstantiated assertion of "Official Notice". In addition, claims 1-14 are rejected as being unpatentable over the combination of the Hoyle patent with U.S. Patent No. 6,317,784 (Mackintosh et al). All of the foregoing rejections are respectfully traversed, as none of the patents relied upon by the Examiner, considered individually, or in the combinations set forth in the Office Action, teach or suggest Applicant's invention as set forth in independent claim 1.

Applicant's Figure 1 shows an exemplary networked computer system wherein communication devices 10 are connected to servers 12 by a communication network 14 such as the Internet. An exemplary banner, comprising a portion of a web page from one site that receives content from a different site, is illustrated in Figure 2. In Figure 2, a web page 20 of web publisher ABC, Inc., whose web site may be hosted on a first server 12a, is illustrated. A banner 24 associated with a different web site XYZ Corp., may be hosted on a different server 12c. Instructions within the code for web page 20 are used to display the banner, and include a reference to the source of information for the banner (e.g., an address associated with server 12c), at which a file containing additional code for specifying contents of the banner 24 are resident.

As shown in Figure 3, an exemplary banner can provide access to multiple different services and thereby function as a multi-site/multi-function portal for the user. As shown therein, the exemplary banner 24a includes a menu 30 for affording the user access to

various categories of content available through the party which has acquired the right to display and control the contents of the banner.

The foregoing features are broadly encompassed by independent claim 1, which is directed to a method for providing multiple types of content for users of the Internet. Claim 1 recites a step of publishing at least one file on at least one file server that provides Internet users with access to a plurality of different types of information and services. Claim 1 further recites establishing a connection between said file and at least one web page that is displayed at an Internet web site; and causing at least some of the contents of said file to appear within a banner whenever a user downloads said page from the display.

Exemplary embodiments of the present invention can provide numerous advantages that are not realized in the systems described by the documents relied upon by the Examiner. For example, by establishing connections between a file published on a file server and a web page displayed at an Internet web site, multiple web pages displayed at multiple web sites can access common banner content. This can provide increased access to the banner content and decrease the access cost the various web page hosts incur for displaying the banner content. The banner content can include valuable information which numerous web page hosts would have an interest in displaying to attract interest to their sites. For example, a virtual network of sites can thereby be tied together using a common banner, thus increasing the value of all sites participating in the virtual network.

None of the documents relied upon by the Examiner are directed to the web site model described in Applicant's specification, such that these documents fail to teach or suggest Applicant's claim 1 combination of features. For example, none of the documents

relied upon teach or suggest the claim 1 feature of establishing a connection between a file published on at least one file server and at least one web page displayed at an Internet web site, such that contents of the file appear within a banner when a user downloads the web page. To the contrary, systems and methods described in the patents relied upon, at best, are directed to a transfer of information from a server to an end user (e.g., to the desktop computer of an end user), and are not directed to establishing a connection between at least one file and at least one file server with a web page displayed at an Internet web site.

The Bernardo patent is directed to a software tool that can be used for creating a web site that can be transferred from a server to an end user. The tool includes a template that can be used to create a web site. A user selects a desired template for the web site to be constructed, and is then prompted through a series of views to populate the fields of the template. Fig. 4 of the Bernardo patent illustrates an exemplary view that is presented to a web site creator for use in creating a web site, and causing contents of the file to appear within a banner whenever a user downloads the page for display.

Because the Bernardo patent is directed to a tool for creating a web site, this patent fails to teach or suggest Applicant's claim 1 combination. For example, there is no teaching or suggestion in the Bernardo patent of establishing a connection between a file published on a file server and a web page displayed at an Internet web site. Referring to Fig. 2 of Bernardo, the tool is included in a server 30 which can access a database 40 containing a library of templates, views and fields (see column 6, lines 26-34). As described in the paragraph bridging columns 6 and 7, a web site creator can access the tool using a network browser resident on a client terminal to build up the web site.

However, the database 40 of the Bernardo patent is merely used to supply information that can be used to create the web site being constructed. While the tool of the Bernardo patent could, for example, be used to build a web side or could possibly be used to separately build a banner, there is no teaching or suggestion of establishing a connection between a web site and a banner. For example, there is no establishing of a connection between a file stored in database 40 in the Bernardo patent and a web page that is displayed at an Internet web site. To the contrary, information from the database 40 in Bernardo is used to create the web page. As such, Bernardo teaches away from any need to "establish a connection" as recited in Applicant's claim 1, so that information in a file on a file server will appear within a banner of a web page whenever a user downloads the page for display. Claim 1 is therefore allowable over the Bernardo patent.

Claim 1 is also allowable over the Hoyle patent. Referring to the Hoyle patent, the abstract describes providing an automatically upgradable software application that includes targeted advertising. The software application is described as a graphical user interface that includes a display region for banner advertising downloaded over the Internet. The software application is described as being accessible from the server via the Internet. According to the Hoyle patent, the user acquires software over the Internet, which then becomes resident on the user's machine. Banner advertising information can then be sent directly to the user. Thus, rather than establishing a connection between a file containing banner advertising and at least one web page displayed at an Internet web site, the Hoyle patent is directed to creating a direct link between an end user and an entity which provides banner advertising. The Hoyle patent fails to teach or suggest establishing a connection between a file and a web page displayed at an Internet web site, and causing contents of the

file to appear within a banner whenever a user downloads the web page for display  
(Applicant's claim 1).

The foregoing distinction can be traced to a fundamental difference in the business model associated with the system of the Hoyle patent versus that of the present invention. In accordance with the Hoyle patent, end users constitute the customer base which would purchase the automatically upgradable software application that can communicate directly with banner advertisers. In contrast, exemplary embodiments of the present invention are directed to web site owners interested in interfacing their web site with multiple types of content to provide more content rich web pages to end users by forming a virtual network of sites.

The remaining rejections based on modifications to the systems of the Bernardo and Hoyle patents rely on unsubstantiated assertions of "Official Notice" and/or reply upon patents which fail to overcome the deficiencies of the Bernardo and Hoyle patents. Applicant's respectfully request that the Examiner provide a specific teaching that the scrolling and search functions of Applicant's claims 5 and 9 are "old and notorious". Similarly, Applicant respectfully requests the Examiner provide a specific teaching that the provision of a headline comprising a link (e.g., claims 6-8), the scrolling features of claim 5, and the features of claims 10-14 are "old and notorious". Applicant's dispute each of the assertions. Applicant's respectfully traverse any assertion that these features, or the features of any of claims 1-15, are taught or suggested by the documents relied upon in the Office Action.

For example, the Mackintosh patent is directed to a media player for playing broadcast material and associated supplemental information. The player includes a receiver

configured to receive broadcast material from a broadcast service provider. As with the Hoyle patent, the Mackintosh patent is directed to creating a direct link between a broadcaster and end users, and precludes end users from controlling the request for material from a file accessed via a web page downloaded by the user for display. Thus, the Mackintosh patent, even when considered in combination with the Hoyle patent, fails to teach or suggest establishing a connection between a file on at least one file server, and at least one web page that is displayed at an Internet web site, such that contents of the file appear within a banner downloaded by a user for display.

Because the patents relied upon by the Examiner fail to teach or suggest Applicant's claim 1 combination of features, this claim is considered allowable. The remaining claims 2-14 recite additional advantageous features of the present invention and further distinguish over the documents relied upon by the Examiner. Claim 15, which was included in the rejection under 35 U.S.C. §112, is also considered allowable.

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: \_\_\_\_\_

Patrick C. Keane

Registration No. 32,858

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

Date: April 8, 2003